

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Edward Seeman
Appl. No.: 10/828,517
Filed: April 19, 2004
Docket No.: 2057
Conf. No.: 4284
Title: **METHOD, SYSTEM, AND COMPUTER-READABLE MEDIUM
FOR CREATING ELECTRONIC LITERARY WORKS,
INCLUDING WORKS PRODUCED THEREFROM**

Art Unit: 2176
Examiner: James J. Debrow

Action: **RESPONSE TO OFFICE ACTION**
Date: September 24, 2008

TO: Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Sir:

The present communication is in response to the office action dated March 25, 2008 for the above-identified application. Filed concurrently herewith is a request for a three-month extension of time making this response due September 25, 2008. Also accompanying this amendment is a new power of attorney and a statement under 37 C.F.R. 3.73(b).

Claims 1-43 are pending in this case. Of these, claims 1, 15, 20, 28 and 37 are independent claims. The current office action is in response to remarks previously filed on December 19, 2007. The Examiner will please note that a typographical error in claim 20 has been corrected.

Upon consideration of Applicant's earlier remarks, the Examiner has now withdrawn all rejections previously maintained. The Examiner has, however, entered new grounds for rejecting all claims of this application. To summarize, claims 1-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Microsoft Word 2000 ("MS Word") in view of US Publication Number 2007/0011607 to Lazareck et al. ("Lazareck"), and further in view of US Pat. No. 7,203,900 to Nara et al. ("Nara"). The particular arguments advanced by the Examiner in rejecting the pending claims are more thoroughly set forth on pages 2-37 of the office action.

Accompanying this response is a declaration of Ed Seeman under 37 C.F.R. §1.131 (the "Seeman Decl.") which antedates the Lazareck reference. Mr. Seeman is a member of Real-E Studios, LLC. The Seeman Decl. establishes that the present invention as claimed in the above-identified patent application was conceived in the United States and reduced to practice prior to the effective date of Lazareck, namely, February 7, 2003.

Under 37 C.F.R. §1.131, affidavits or declarations are appropriate for overcoming a reference which has a priority date under 35 U.S.C. §102(a) prior to the applicant's effective filing date, and shows but does not claim the same patentable invention. See MPEP §715. Moreover, the Seeman Decl. is seasonably presented under MPEP §715.09 because it is submitted prior to a final rejection.

Among the numerous features described in detail in Exhibit B to the Seeman Decl. are an archive image set; the generation of a contact sheet view comprising an imported image set; the establishment of a working image set through population of a second working area of the application program with selected digital images; the

arrangement of digital images from the working image set into a selected storyboard sequence; the association of respective image data with images from the working image set to define pairs of companion image items; and the display of the companion image items according to the storyboard sequence. The Seeman Decl., thus, conclusively sets forth facts sufficient to demonstrate conception and reduction to practice of the invention prior to the effective date of Lazareck.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number listed below.

Respectfully submitted,



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